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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/325,910	06/04/1999	KEITH E. MOORE	10990146-1	3440

22879 7590 01/03/2003

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EXAMINER

SINGH, RACHNA

ART UNIT PAPER NUMBER

2176

DATE MAILED: 01/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/325,910

Applicant(s)

MOORE, KEITH E.

Examiner

Rachna Singh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: application, filed 6/4/99.
2. Claims 1-20 are pending in the case. Claims 1, 7, and 13 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4, 7-8, 10, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al., US Patent 4,985,930, 1/15/91 in view of Irons, US Patent 6,192,165, 2/20/01 and Hug et al., US Patent 5,806,078, 9/8/98.

In reference to claim 1, Takeda discloses an image data filing system and image data correcting method in which a user writes correction information for a document on a correction paper. The correction paper is then converted into a second image data from which a corrected image data is formed. See column 2 and column 13, lines 5-28. While Takeda discloses the scanning of a document with corrections or modifications, he does not teach using an identifier code on the substrate; however, Irons teaches scanning a document with a bar-coded label in order to identify and index a document with other related documents. See columns 6-10. Irons further teaches filing the images with associated records in a repository or database. The document number is used to link the document image to a record in the database. It would have been

obvious to one of ordinary skill in the art to modify Takeda's method of scanning a corrected document with Irons' system for labeling a document for indexing and image storage and retrieval since Irons' system allows the user to index and label the documents prior to scanning by using a labeling mechanism. Upon scanning, the user can then associate the document with other documents in the database record.

Takeda and Irons do not disclose comparing the second communication with the data of the first communication to identify differences; however, Hug discloses a version management system in which a difference report is generated to emphasize the differences between multiple versions of a document. See abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a difference report as disclosed by Hug with the system disclosed jointly by Takeda and Irons since their system consists of modified/corrected versions of the same document.

In reference to claim 2, Takeda allows the user to change the document by writing correction information on the correction paper. The corrections are read in and synthesized with image data from the original. See column 2.

In reference to claim 3, Hug discloses generating a difference report regarding the changes between the multiple versions of a document. See abstract.

In reference to claim 4, Takeda discloses a pattern matching means in which the difference between the original and corrected image data is used to synthesize the image data. The new corrected image includes the corrected portion and the non-corrected portion. See column 2.

In reference to claim 7, as discussed above in reference to claim 1, Takeda and Irons jointly teach a system in which a database consists of multiple versions of the same document. Irons specifically discloses the bar-coded label which is used to index the document within a record in the database while Takeda discloses a correction of a hard copy of various document versions. See claim 1 above.

In reference to claim 8, Takeda and Irons do not disclose comparing the second communication with the data of the first communication to identify differences; however, Hug discloses a version management system in which a difference report is generated to emphasize the differences between multiple versions of a document. See abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a difference report as disclosed by Hug with the system disclosed jointly by Takeda and Irons since their system consists of modified/corrected versions of the same document.

In reference to claim 10, Hug discloses various dialogues that are presented to the user. These dialogues consist of file versions in which the user can compare and view differences between various versions of the document. The user can also move or copy the documents. See columns 9-10. It would have been obvious to one of ordinary skill in the art at the time of the invention to prompt the user for indicating which portions to extract from the database since both the system disclosed by Hug and jointly by Takeda and Irons deal with various versions of a document.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al., US Patent 4,985,930, 1/15/91 in view of Irons, US Patent 6,192,165, 2/20/01 and

Hug et al., US Patent 5,806,078, 9/8/98, as applied to claim 1 above, and further in view of Oliver, US Patent 6,330,082, 12/11/01.

In reference to claim 5, Oliver discloses the use of a hand-held scanner. See figures 1-8 and columns 1-2. The processor is separate in that it is stored in the computer. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a separate scanner since it was well known at the time of the invention.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al., US Patent 4,985,930, 1/15/91 in view of Irons, US Patent 6,192,165, 2/20/01 and Hug et al., US Patent 5,806,078, 9/8/98, as applied to claim 1 above, and further in view of Belucci et al., US Patent 5,913,542, 6/22/99 and Outwater et al., US Patent 6,203,069, 3/20/01.

In reference to claim 6, Takeda, Irons and Hug do not disclose an identifier code in which the pattern is either camouflaged or invisible to users. However, Belucci discloses a system in which identification indicia are camouflaged. See figure 1B and Outwater discloses a system in which the label has an invisible bar code that is invisible under certain light. See abstract. It would have been obvious to one of ordinary skill in the art to utilize a hidden identifier code on the substrate, since it is well known in the art to utilize such features for data protection.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al., US Patent 4,985,930, 1/15/91 in view of Irons, US Patent 6,192,165, 2/20/01 and

Hug et al., US Patent 5,806,078, 9/8/98, as applied to claim 1 above, and further in view of Edens et al., US Patent 6,249,716, 6/19/01.

In reference to claim 9, Edens discloses a system for printing and finishing documents. Specifying the finishing and printing operations for a hard copy document is well known in the art of book printing. See columns 1-3. Thus it would have been obvious to extend the feature of printing and finishing specifications to that of hard copy documents since it was common in the art to utilize such features in document processing.

8. Claims 11, 12, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda et al., US Patent 4,985,930, 1/15/91 in view of Irons, US Patent 6,192,165, 2/20/01 and Hug et al., US Patent 5,806,078, 9/8/98, as applied to claims 1 and 7 above, and further in view of Kelley et al., US Patent 6,405,223, 6/11/02.

In reference to claim 11, the system disclosed by Takeda and Irons does not state using multiple sub-components that can be updated independently; however, Kelley teaches storing different versions of a webpage document in which different versions of web source information are stored in a database such as text data, graphic data files, and any code used to output an URL. See columns 3-6. The various components have different version numbers associated with the information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system disclosed jointly by Takeda and Irons since Kelley's system deals with multiple versions of a document, as do Takeda and Irons. Thus it would have made

sense to provide version numbers for those sub-components that make up the document such as text and graphics.

In reference to claim 12, Hug discloses various dialogues that are presented to the user. These dialogues consist of file versions in which the user can compare and view differences between various versions of the document. The user can also move or copy the documents. See columns 9-10. Hug does not teach this system for sub-components as taught by Kelley's system; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to extend this system for sub-components since those sub-components are also stored in the database with version numbers.

In reference to claim 13, as discussed above in reference to claim 1, Takeda and Irons jointly disclose a system in which multiple versions of a document are stored in a database. See above. Takeda and Irons do not disclose a system in which the first and second data sets are compared. However, Hug discloses various dialogues that are presented to the user. These dialogues consist of file versions in which the user can compare and view differences between various versions of the document. The user can also move or copy the documents. See columns 9-10. It would have been obvious to one of ordinary skill in the art at the time of the invention to prompt the user for indicating which portions to extract from the database since both the system disclosed by Hug and jointly by Takeda and Irons deal with various versions of a document.

In reference to claim 14, the system disclosed by Takeda and Irons does not state using sub-components identifiers; however, Kelley teaches storing different

versions of a webpage document in which different versions of web source information are stored in a database such as text data, graphic data files, and any code used to output an URL. See columns 3-6. The various components have different version numbers associated with the information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system disclosed jointly by Takeda and Irons since Kelley's system deals with multiple versions of a document, as do Takeda and Irons. Thus it would have made sense to provide version numbers for those sub-components that make up the document such as text and graphics.

In reference to claim 15, the system disclosed by Takeda and Irons does not state using sub-components identifiers; however, Kelley teaches storing different versions of a webpage document in which different versions of web source information are stored in a database such as text data, graphic data files, and any code used to output an URL. See columns 3-6. The various components have different version numbers associated with the information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system disclosed jointly by Takeda and Irons since Kelley's system deals with multiple versions of a document, as do Takeda and Irons. Thus it would have made sense to provide version numbers for those sub-components that make up the document such as text and graphics. Kelley does not allow the user to compare sub-components, but Hug discloses a system in which a dialogue is presented to the user allowing the user to compare and view differences between various versions of the document. The user can also move or copy the documents. See columns 9-10. Hug does not teach this system for sub-

components as taught by Kelley's system; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to extend this system for sub-components since those sub-components are also stored in the database with version numbers.

In reference to claim 16, Hug discloses using a scanner to provide the identifier code. He does not disclose a voice input or tactile input to the processor. However, it is obvious to one of ordinary skill in the art to provide various forms of input including that of a voice input and tactile input.

In reference to claim 17, Takeda and Irons do not disclose comparing the second communication with the data of the first communication to identify differences; however, Hug discloses a version management system in which a difference report is generated to emphasize the differences between multiple versions of a document. See abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate a difference report as disclosed by Hug with the system disclosed jointly by Takeda and Irons since their system consists of modified/corrected versions of the same document.

In reference to claim 18, Kelley teaches a system for identifying and accessing various sub-components for a version of a document for display on a web page. Kelley does not disclose printing or sending it via email; however, it is well known in the art to output a hard copy of a document or send it via email.

In reference to claim 19, the system disclosed by Takeda and Irons does not state using sub-components identifiers; however, Kelley teaches storing different

versions of a webpage document in which different versions of web source information are stored in a database such as text data, graphic data files, and any code used to output an URL. See columns 3-6. The various components have different version numbers associated with the information. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system disclosed jointly by Takeda and Irons since Kelley's system deals with multiple versions of a document, as do Takeda and Irons. Thus it would have made sense to provide version numbers for those sub-components that make up the document such as text and graphics. Kelley does not allow the user to detect multiple versions of one or more sub-components, but Hug discloses a system in which a dialogue is presented to the user allowing the user to compare and view differences between various versions of the document. See columns 9-10. Hug does not teach this system for sub-components as taught by Kelley's system; however, it would have been obvious to one of ordinary skill in the art at the time of the invention to extend this system for sub-components since those sub-components are also stored in the database with version numbers.

In reference to claim 20, Hug discloses various dialogues that are presented to the user. These dialogues consist of file versions in which the user can compare and view differences between various versions of the document. The user can also move or copy the documents. See columns 9-10. It would have been obvious to one of ordinary skill in the art at the time of the invention to prompt the user for indicating which portions to extract from the database since both the system disclosed by Hug and jointly by Takeda and Irons deal with various versions of a document.

Response to Arguments

9. In response to applicant's argument regarding claim 1 that the ***"mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests desirability of the combination"***, the test for obviousness is not whether the features of the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Takeda illustrates a method in which an image data filing system and image data correcting method are utilized to convert a second image data into a corrected image. He teaches filing the results in a database. Irons teaches scanning a document with a bar-coded label in order to identify and index the document related to others. It would have been obvious to one of ordinary skill in the art to combine Takeda and Irons as both are of analogous art in the field of document filing. Moreover, one of ordinary skill in the art at the time of the invention would have been motivated to combine Takeda and Irons as

there was a need in the art to obtain corrected information and store it with the appropriate file. See abstract of Takeda.

Applicant further argues, "***Why would one of ordinary skill in the art look to Irons to modify the invention of Takeda when Takeda already provides for the teaching for which Irons is allegedly presented?***" This argument illustrates essentially why the combination of Takeda and Irons is not lacking a motivation. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Takeda and Irons disclose the subject matter sought to be patented when taken in combination as discussed above and in the rejections above. One of ordinary skill would modify Takeda's invention with Irons as both are concerned with filing documents for storage and retrieval.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was

within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that Oliver is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Oliver is utilized to demonstrate that hand-held scanners used to digitize documents were well known in the art. Thus it is reasonable pertinent to the claimed "digitizing device" in claim 5.

In response to applicant's argument that Belucci is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Belucci is pertinent to a particular problem claimed by the applicant dealing with camouflaging identification indicia.

As requested by the Applicant, the following is a list of limitations and how the prior art compares to it:

Takeda teaches the following elements:

-an image data filing system and image data correcting method in which the user writes correction information for a document on a correction document. A document image to be corrected is read out from an image file which stores document images, an operator writes correction information on the correction paper which is in turn inputted into the image file system with an image reader. (Compare to "storing a first communication as data in a database", "changing the first communication on a substrate to form a second communication which is different from the first communication", "scanning the second communication. . .to digitize the second communication")

Takeda does not teach using an identifier code on the substrate; however, Irons teaches scanning a document with a bar-coded label in order to identify and index a document with other related documents. Irons further teaches filing the images with associated records in a repository or database. The document number is used to link the document image to a record in the database. (Compare to "associating at least a portion of the first communication together with the identifier code on a substrate; scanning the . . . identifier code with a scanning machine to digitize the. . . identifier code; extracting information from the digitized identifier code with a processor. . .the processor being in data communication with the database and being configured to utilize the extracted information to retrieve the first communication from the database."

Irons does not teach the comparison of the digitized second communication with the data of the first communication; however, Hug discloses generating a difference report in which the differences between various versions of a document are emphasized.

Please see the rejection for claims and response to arguments above for motivation and reasons to combine.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6,327,599	Warmus et al.	12/4/01
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US Patent 6,104,834	Hull	8/15/00
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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh at 703.305.1952. The examiner can normally be reached on Monday-Friday from 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached at 703.308.5186.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 703.305.3900.

Any response to this action should be mailed to:

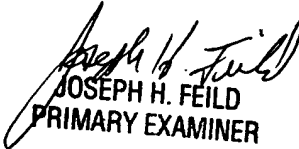
Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

After-Final	703.746.7238
Official	703.746.7239
Non-Official/Draft	703.746.7240

Hand-Delivered responses should be brought to Crystal park II, 2121 Crystal Drive, Arlington VA., Sixth Floor (Receptionist).

Rachna Singh
December 26, 2002


JOSEPH H. FEILD
PRIMARY EXAMINER